

**REMARKS**

Claims 1-28 are pending in the application and stand rejected by the Examiner. The outstanding issues in the current Office Action are:

- Claims 1, 2, 5, 6, and 16-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,000,608 to Dorf *et al.* ("the Dorf patent");
- Claims 7-9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by PCT International Publication No. WO 98/47112 ("the Miller reference");
- Claims 22 and 24-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,246,755 to Walker *et al.* ("the Walker patent");
- Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Dorf patent;
- Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,257,487 to Hayashida ("the Hayashida patent"); and
- Claims 10-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of International Publication No. WO 98/25237 ("the Taskett reference").

**Amendments to the Claims**

Claim 11 is rewritten in independent form to include all of the limitations of claim 10 from which claim 11 previously depended. Amended claim 11 contains no new matter and no new elements because it always included the elements of claim 11. 35 U.S.C. § 112, ¶ 4. The dependency of claims 12-14 have been amended to reflect the amendment of claim 11.

Claim 23 is rewritten in independent form to include all of the limitations of claim 22 from which claim 23 previously depended. Amended claim 23 contains no new matter and no new elements because it always included the elements of claim 22. 35 U.S.C. § 112, ¶ 4.

Applicant has added new claims 29-40, including independent claim 3<sup>4</sup>~~7~~. Claims 29-40 are supported by the specification on page 9, line 2 through page 21, line 13 and, more specifically, on page 16, lines 2-19. No new matter has been added in these claims.

Applicant has also cancelled claims 1-10, 16-22, and 24-26.

**Rejection of Claim 11**

Claims 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Taskett.

Claim 11 recites, in part:

receiving transaction messages following individual replenishment transactions by said consumers;

receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;

reconciling said individual transactions; and

sending a message indicating the disbursement of funds associated with said replenishment transactions.

Applicant notes that the Examiner has asserted with respect to claim 11 that Miller discloses similar steps. Specifically, the Examiner cites pages 22 and 23 of Miller to support the rejection of claim 11. However, Miller merely discloses that its prepaid system includes “audit trail data bases” 5 and that “[t]he PIN in this instance will be replaced by a reference code for audit trail purposes.” Page 22, line 10 and page 23, lines 16-17. Miller does not provide further details and does not disclose how audit trail processing occurs. Moreover, Miller does not teach or suggest receiving summary data or reconciling individual replenishment transactions. Clearly, the disclosure of Miller is insufficient to render the preceding limitations of claim 11 unpatentable over Miller.

Additionally, Taskett merely discloses creating a summary of transaction related to a single consumer’s account. Taskett does not teach or suggest summarizing substantially all individual transactions that occurred during a certain period. Moreover, Taskett does not teach or suggest reconciling said individual transactions.

Accordingly, Miller and Taskett, either alone or in combination, do not teach or suggest each and every limitation of claim 11. Claims 12-14 depend from claim 11 and, hence, inherit all limitations of claim 11. Therefore, a prima facie case of obviousness has not been established for claims 11-14. *See* M.P.E.P. § 2143. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 11-14 and pass the claims to issue.

Additionally, Applicant notes that new claims 28-33 depend from claim 11 and, hence, inherit all limitations of claim 11. Accordingly, Applicant respectfully submits that

claims 28-33 are allowable and Applicant requests the Examiner to pass claims 28-33 to issue.

### **Rejection of Claim 15**

The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over the Dorf patent. In the Examiner's comments only some of the elements of claim 15 are noted as being found in the Dorf patent. The Examiner goes on to admit that "Dorf fails to disclose receiving summary data from the bank, wherein the summary data comprises information related to a plurality of replenishment transactions; reconciling individual replenishment transactions by comparing the real time data with summary data." Office Action at 8. The Examiner provides no further discussion regarding where to find the elements that are missing from the Dorf patent.

The test for non-obvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in *Graham v. John Deere and Co.*, 383 U.S. 1 (1966) sets forth the factual inquiries which must be considered in applying the statutory test: (1) determining of the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art, and (4) evaluate evidence of secondary considerations. M.P.E.P. § 2141.

The M.P.E.P. § 706.02(j), incorporates the mandate of *Graham v. John Deere* and directs the Examiner to set forth in the Office action: (1) the relevant teachings of the prior art relied upon; (2) the difference or differences in the claim over the applied references; (3) the proposed modification of the applied references necessary to arrive at the claimed subject matter; and (4) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The rejection of claim 15, as stated in the Office Action does describe some of the differences between claim 15 and the cited Dorf reference. However, the Office Action does not provide another reference that contains teachings or suggestions related to the admitted differences. Moreover, the Office Action does not state that the Dorf patent should be modified or combined with any teachings or suggestions of another reference to address the admitted differences. Lastly, the Office Action does not provide an explanation as why one of ordinary skill in the art, at the time the invention was made, would make any

modifications.

Therefore, Applicant respectfully submits that the rejection of claim 15 is improper because it does not satisfy the mandate of *Graham v. John Deere*. Moreover, following the Examiner's analysis of Dorf, a prima facie case of obviousness has not been established for claim 15, because the cited art does not teach or suggest each and every limitation of claim 15. *See* M.P.E.P. § 2143.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 15 and pass the claim to issue.

### **Rejection of Claims 23, 27 and 28**

Applicant notes that the Examiner has not set forth a specific statutory basis for the rejection of claims 23, 27 and 28 in the present Office Action. Instead, the Office Action includes remarks directed to certain elements of these claims without indicating where the remaining elements can be found.

The Office Action does not identify a statutory basis for rejecting claim 23. Claim 23 originally depended from claim 22, but has been rewritten in independent form in the present Amendment. Claim 22 was rejected under 35 U.S.C. § 102(e) as being anticipated by the Walker patent. Office Action at 6. Claim 23 was not included in this rejection. Instead claim 23 was discussed in a separate portion of the Office Action without reference to any statute. *See* Office Action at 12-13.

The Office Action merely states that replenishment of calling cards is "old and well known" and takes "official notice" of replenishment of prepaid accounts in cellular networks. *Id.* at 12. However, other than claiming that these general concepts of prepaid replenishment are well known, the Office Action fails to state that the specific elements of claim 23 are well known in the prior art.

Claims 27 and 28 are both independent claims. The current Office Action discusses these claims in the same section in which it addresses claim 23. Office Action at 12-13. Again, no statutory basis is given for rejecting claims 27 and 28. *See id.* Moreover, other than claiming that the general concepts of prepaid replenishment are well known, the Office Action fails to state that all of the elements of claim 27 and 28 are well known in the prior art. Accordingly, the present Office Action fails to address each and every element of claims 27 and 28.

Applicant requests that the Examiner provide a proper statutory basis for rejecting claims 23, 27 and 28 in a subsequent non-final Office Action or, alternatively, indicate that claims 23, 27 and 28 are allowable. *See* M.P.E.P. §§ 707.07 and 707.07(d).

**Traversal of “Well Known” Statement**

On pages 12 and 13 of the current Office Action, the Examiner states that certain elements are “notoriously old and well known” and takes “OFFICIAL NOTICE . . . of replenishment of prepaid card accounts in cellular phone networks.” Applicant traverses these allegations in accordance with M.P.E.P. § 2144.03. Applicant submits that the specific elements required in the pending claims are not found in the prior art and respectfully requests that the Examiner provide one or more references (that are valid under 35 U.S.C. § 102) that illustrate the elements of the pending claims.

Specifically, with respect to claim 23, the Examiner has not shown that the following steps are known in the prior art:

- prompting said users for a wireless telephone number; and
- prompting said users for a personal identification number.

Additionally, the following elements of claim 27 are missing from the cited prior art:

- a processor that receives network messages associated with a user-dialed replenishment code, wherein said network messages comprise wireless telephone identification information and personal identification number (PIN) information;
- a replenishment database comprising prepaid account information for said users;
- said processor having means for identifying users by extracting said wireless telephone identification information and authenticating said PIN information; and
- said processor having means for initiating a replenishment transaction using account information for said user, wherein said account information for said identified user is retrieved from said database.

The following elements of claim 28 are also missing from the cited prior art:

- receiving dialed digits from a wireless device;
- identifying the wireless device using calling number information contained in network messages associated with said wireless device;
- detecting a personal information number (PIN) from said dialed digits;
- selecting, from a database, a prepaid account associated with said wireless

device; and  
replenishing said prepaid account by adding a designated amount.

Applicant respectfully requests that the Examiner provide a prior art reference to support the statement that these elements are “notoriously old and well known” in wireline and cellular telephone networks. M.P.E.P. 2144.03. Alternatively, should the Examiner fail to find these elements in a prior art reference, Applicant requests that the Examiner indicate that claims 23, 27 and 28 are allowable.

### **New Claims**

Claim 34 recites, in part:

means for sending a message to a prepaid engine from a replenishment system, wherein said update message comprises information regarding an amount of money to be added to said prepaid account;

means for receiving summary data from said bank, wherein said summary data comprises information related to a plurality of said replenishment transactions;

means for reconciling individual replenishment transactions by comparing said real time data with said summary data; and

means for sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

Applicant respectfully submits that the cited art, either alone or in combination, does not teach or suggest the preceding limitations. In particular, Applicant notes that the Examiner has asserted with respect to claim 11 that Miller discloses similar subject matter. Specifically, the Examiner cites pages 22 and 23 of Miller to support the rejection of claim 11. However, Miller merely discloses that its prepaid system includes “audit trail data bases” 5 and that “[t]he PIN in this instance will be replaced by a reference code for audit trail purposes.” Page 22, line 10 and page 23, lines 16-17. Miller does not provide further details and does not disclose how audit trail processing occurs. Moreover, Miller does not teach or suggest receiving summary data or reconciling individual replenishment transactions. Clearly, the disclosure of Miller is insufficient to render the preceding limitations of claims 34 unpatentable over Miller.

Accordingly, Applicant respectfully submits that claim 34 is patentable over the cited art. Claims 35-40 depend from claim 34 and, hence, inherit all limitations of claim 34. Therefore, Applicant respectfully submits that claims 35-40 are also patentable over the cited

art.

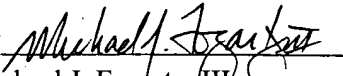
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

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Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please cancel claims 1-10.

11. (Amended) ~~The method of claim 10~~ A method of providing prepaid account services to consumers comprising the steps of:  
assigning prepaid accounts to said consumers;  
associating said prepaid accounts with wireless telephones;  
communicating with a banking network regarding consumer replenishment transactions, wherein said communicating with said banking network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers;

receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;

reconciling said individual transactions; and

sending a message indicating the disbursement of funds associated with said replenishment transactions;

and

communicating with a prepaid engine regarding said consumer replenishment transactions.

12. The method of claim ~~40~~11 wherein said communicating with said prepaid engine further comprises the step of:

sending a message indicating an amount to be added to a particular prepaid account.

13. The method of claim ~~40~~11 wherein said bank is a banking institution.

14. The method of claim ~~40~~11 wherein said bank is an entity that supports financial transactions over a point of sale network.

15. A method of providing prepaid account replenishment services comprising the steps of:

receiving real time data from a bank, wherein said data comprises information related to a replenishment transaction;

identifying a prepaid account number from said data;

sending an update message to a prepaid engine, wherein said update message comprises information regarding an amount of money to be added to said prepaid account;

receiving summary data from said bank, wherein said summary data comprises information related to a plurality of replenishment transactions;

reconciling individual replenishment transactions by comparing said real time data with said summary data; and

sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

Please cancel 16-22.

23. (Amended) A method for replenishing prepaid accounts comprising the steps of:

receiving, at a voice response unit, calls from users desiring to replenish said prepaid accounts;

identifying each of said users;

prompting said users to select replenishment amounts;

processing replenishment transactions by causing the transfer of said replenishment amounts from a designated source account to said prepaid accounts;

~~The method of claim 22 wherein said identifying step further comprises:~~

prompting said users for a wireless telephone number; and

prompting said users for a personal identification number.

Please cancel claims 24-26.

27. A wireless network system for replenishing prepaid accounts comprising:  
a processor that receives network messages associated with a user-dialed replenishment code, wherein said network messages comprise wireless telephone identification information and personal identification number (PIN) information;  
a replenishment database comprising prepaid account information for said users;  
said processor having means for identifying users by extracting said wireless telephone identification information and authenticating said PIN information; and  
said processor having means for initiating a replenishment transaction using account information for said user, wherein said account information for said identified user is retrieved from said database.
28. A method for replenishing prepaid accounts comprising the steps of:  
receiving dialed digits from a wireless device;  
identifying the wireless device using calling number information contained in network messages associated with said wireless device;  
detecting a personal information number (PIN) from said dialed digits;  
selecting, from a database, a prepaid account associated with said wireless device; and  
replenishing said prepaid account by adding a designated amount.
29. (New) The method of claim 11 wherein said receiving transaction messages following individual replenishment transactions by said consumers further comprises:  
verifying location identification information associated with received transaction messages, wherein said location identification information identifies authorized replenishment locations.
30. (New) The method of claim 11 wherein said receiving transaction messages following individual replenishment transactions by said consumers further comprises:  
verifying that permanent account numbers have been activated.
31. (New) The method of claim 11 wherein said receiving transaction messages following individual replenishment transactions by said consumers further comprises:  
verifying that transaction identifiers associated with received transaction messages are not duplicates.

32. (New) The method of claim 11 wherein said reconciling said individual transactions comprises:

identifying transactions messages that are in variance with information contained in said reconciliation message; and

logging said identified transaction messages in an exception file.

33. (New) The method of claim 11 further comprising:  
sending a disbursement message to a bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

34. (New) A system for replenishing prepaid accounts wherein real-time data is received from a bank, said real-time data comprising information related to a replenishment transaction and said data identifying a prepaid account, wherein the system comprises:

means for sending a message to a prepaid engine from a replenishment system, wherein said update message comprises information regarding an amount of money to be added to said prepaid account;

means for receiving summary data from said bank, wherein said summary data comprises information related to a plurality of said replenishment transactions;

means for reconciling individual replenishment transactions by comparing said real time data with said summary data; and

means for sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

35. (New) The system of claim 34 wherein said bank is a banking institution.

36. (New) The system of claim 34 wherein said bank is an entity that supports financial transactions over a point of sale network.

37. (New) The system of claim 34 further comprising:  
means for verifying location identification information associated with real time data from said bank, wherein said location identification information identifies authorized replenishment locations.

38. (New) The system of claim 34 further comprising:  
means for verifying that permanent account numbers have been activated.

39. (New) The system of claim 34 further comprising:  
means for verifying that transaction identifiers associated with real time data from  
said bank are not duplicates.

40. (New) The system of claim 34 further comprising:  
means for identifying replenishment transactions that are in variance with information  
contained in said summary data; and  
means for logging replenishment transactions identified by said means for identifying  
into an exception file.